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10/645,185	08/21/2003	Winthrop Childers	200208971-1	7057

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EXAMINER
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SALLIARD, SHANNON S

ART UNIT	PAPER NUMBER
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3628

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
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8 *Ex parte* WINTHROP CHILDERS  
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11 Appeal 2009-006270  
12 Application 10/645,185  
13 Technology Center 3600  
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16 Decided: June 21, 2010  
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20 *Before* MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R.  
21 MOHANTY, *Administrative Patent Judges*.

22  
23 CRAWFORD, *Administrative Patent Judge*.  
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25  
26 DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 (2002) from a Final Rejection of claims 1-33. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented online systems and methods for requesting a projector and presentation venue reservation (Abstr.).

Independent claim 1 under appeal reads as follows:

1. A projector reservation system, comprising:
  - a reservation system server capable of communicating over a network with a client that fulfills projector and venue reservation requests received via the network and coordinates a transport and a storage of presentation data received via the network; and
  - one or more projector systems capable of communicating with the reservation system server that download the presentation data for display according to the projector and venue reservation requests.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Hotaling	US 5,124,912	Jun. 23, 1992
Nishihara	US 2003/0208565 A1	Nov. 6, 2003
Lee et al.	US 2004/0039723 A1	Feb. 26, 2004
Dorenbosch	US 2004/0064355 A1	Apr. 1, 2004
Johnson	US 7,143,177 B1	Nov. 28, 2006
Lee	US 2006/0010317 A1	Jan. 12, 2006
Hamid	US 2006/0288229 A1	Dec. 21, 2006

The Examiner rejected claims 1, 5, and 7 under 35 U.S.C. § 103(a) as being unpatentable over Dorenbosch in view of Lee et al.; rejected claims 2 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Dorenbosch in

view of Lee et al. and Official Notice; rejected claims 3, 4, and 31 under 35 U.S.C. § 103(a) as being unpatentable over Dorenbosch in view of Lee et al. and Hamid; rejected claims 8, 11, 14, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Dorenbosch in view of Lee et al. and Lee; rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Dorenbosch in view of Lee et al., Lee, and Hotaling; rejected claims 10, 12, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Dorenbosch in view of Lee et al., Lee, and Official Notice; rejected claims 15, 18-22, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Dorenbosch in view of Lee et al. and Johnson; rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Dorenbosch in view of Lee et al., Johnson, and Hamid; rejected claims 17 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Dorenbosch in view of Lee et al., Johnson, and Nishihara; rejected claims 23-25 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Dorenbosch in view of Lee et al., Hamid, and Official Notice; rejected claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. in view of Johnson and Hamid; rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Dorenbosch in view of Lee et al., Hamid, and Johnson; and rejected claim 33 under 35 U.S.C. § 103(a) as being unpatentable over Dorenbosch in view of Lee et al., Hamid, and Nishihara.

We AFFIRM.

### ISSUE

Did the Examiner err in asserting that the Childers Declarations of August 17, 2007 and March 26, 2008 do not set forth sufficient facts to antedate the Lee et al. and Dorenbosch references?

FINDINGS OF FACT

*Childer's Declaration of August 17, 2007 (First Declaration)*

The Childer's Declaration states:

Following my conception prior to October 1, 2002, I worked diligently with the Patent Attorney, Leland Wiesner, Esq.[.] to prepare the patent application filed on August 21, 2003 thereby constructively reducing the invention to practice. During this time period, the patent attorney prepared one or more drafts of the application for my comments. With my comments, the patent attorney revised one or more portions of the application, claims and/or figures to accommodate my suggestions.

(¶6).

PRINCIPLES OF LAW

*Antedating References*

If a patent is available as a reference against appellant, the burden is on appellant to establish the facts necessary to ““overcome”” that patent. *In re Facius*, 408 F.2d 1396, 1403-04 (CCPA 1969).

Actual reduction to practice requires proof of a physical embodiment or performance of a process that includes all limitations of the claims. *UMC Elecs. Co. v. U.S.*, 816 F.2d 647, 652 (Fed. Cir. 1987).

The presence or absence of reasonable diligence must necessarily be determined by the evidence adduced in each case. *Gould v. Schawlow*, 363 F.2d 908, 919 (CCPA 1966).

ANALYSIS

*Antedating References*

We are not persuaded that the Examiner erred in asserting that the Childers Declarations of August 17, 2007 and March 26, 2008 do not set forth sufficient facts to antedate the Lee et al. and Dorenbosch references (App. Br. 11-16; Reply Br. 5-10). Specifically, Appellant has not met their burden of establishing sufficient facts in the record to overcome the Lee et al. and Dorenbosch references. *See In re Facius*, 408 F.2d at 1403-04.

We initially note that Appellant has not set forth any evidence of an actual reduction to practice of the claimed invention. Contrary to Appellant's arguments, even an enabled disclosure document is not sufficient to establish an actual reduction to practice for a method (Reply Br. 5-7). Evidence of an actual performance of a method is necessary. *See UMC Elecs. Co. v. U.S.*, 816 F.2d at 652.

The entirety of facts on record to support Appellant's diligence, from September 12, 2002 to August 21, 2003, is a statement in the First Declaration that the inventor worked with a patent attorney during this period to draft and revise the patent application (§6). Such a statement, in the absence of additional evidence as to exactly what events in the course of application drafting occurred on which days, is insufficient to meet Appellant's burden of overcoming the Lee et al. and Dorenbosch references. *See Gould v. Schawlow*, 363 F.2d at 919 (CCPA 1966); *In re Mulder*, 716 F.2d 1542, 1545 (Fed. Cir. 1983) (lack of evidence of activity for at least three months between the time the draft application was received in this country and the time the application was filed held to be fatal). *Compare Gould v. Schawlow*, 363 F.2d at 916-17 (testimony of patent attorney

1 relating to their joint activities in preparing a patent application from  
2 December 1958 to April 1959 was a sufficient showing of diligence); *Rines*  
3 *v. Morgan*, 250 F.2d 365, 369 (CCPA 1957) (voluminous record, including  
4 testimony of attorney, shows diligence between November 1943 and the  
5 filing of the patent application on March 18, 1944). While Appellant does  
6 set forth December 26, 2002 as the start date of the RFQ and April 14, 2003  
7 as the date where Mr. Wiesner's services were formally contracted,  
8 Appellant has not provided any evidence to support these events (Reply Br.  
9 8-10).

10 We have reviewed Appellant's arguments on pages 8-10 of the Reply  
11 Brief concerning lack of access to draft applications and delays due to  
12 internal company procedures. However, such arguments cannot take the  
13 place of evidence necessary to meet Appellant's burden.

14 Regarding Appellant's argument on pages 10-11 of the Reply Brief  
15 concerning Official Notice, because such arguments were not set forth in the  
16 Appeal Brief and no good cause has been set forth for their exclusion, we  
17 decline to address them. *See Ex Parte Borden*, 93 USPQ2d 1473, 1477  
18 (BPAI 2010) (expanded panel) (informative) ("the Rules do not require the  
19 Board to take up a belated argument that has not been addressed by the  
20 Examiner, absent a showing of good cause").

1 DECISION

2 The decision of the Examiner to reject claims 1-33 is affirmed.

3 No time period for taking any subsequent action in connection with  
4 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
5 § 1.136(a)(1)(iv) (2007).

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7 AFFIRMED

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